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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER MATTISON, LORI K	
			ART UNIT	PAPER NUMBER
			1619	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/585,209

Applicant(s)

SIMONET ET AL.

Examiner

LORI MATTISON

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/03/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Status of Claims

Claims 1-19 are pending and are currently under examination. This is the first Office Action on the merits.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The examiner notes that no IDS statements were filed prior to the first action on the merits.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because legal phraseology is present. In particular, "comprising." Correction is required. See MPEP § 608.01(b).

Claim Objections

Improper Multiple Dependent Claims

Claims 6, 7, 9-17 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 provides for the use of a composition for washing and/or conditioning keratin materials, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass.

A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 2-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation weight ratio between 4.5 and 19, and the claim also recites more preferably 4.5 and 15 which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 19 are rejected under 35 U.S.C. 102(b) as being unpatentable over US Patent No. 4,940,576 (hereinafter the '576) by Walsh, as evidenced by the Merquat 100 product information guide and US Patent No. 5,744,062 (hereinafter '062) by Dahms *et al.*

Claim 1: The '576 prior art teaches an equivalent composition. Example 4 (Col. 7) teaches a composition which comprises the surfactant sodium lauryl ether sulphate. The composition comprises the water soluble mineral, sodium chloride, in an amount of 12% by weight of the composition. The composition also comprises the cationic

polymer Merquat 100 in an amount that is 1% by weight of the composition. As evidenced by the Merquat product information sheet, Merquat 100 has a molecular weight (i.e. mass) of 1.5×10^5 . With regard to the ratio of water-soluble salt: cationic polymer, the ratio of sodium chloride to Merquat 100 is 12. With regard to the cosmetic composition having a cosmetically acceptable aqueous medium, example 4 contains the aqueous medium, water.

With regard to the composition being a water-in-water emulsion, the '576 prior art does not specifically disclose that the composition is a water-in-water emulsion. However, there are several features in the '576 prior art which suggest that the composition is a water-in-water emulsion. The '576 prior art discloses "liquid crystals" (Col 1, lines 35-45) which are analogous to "droplets" as disclosed by the instant specification. The liquid crystal phase may have a lamellar structure (Col. 3, lines 20-25). As evidenced by the '062 prior art, emulsions may contain a lamellar liquid crystalline phase (Col. 2, lines 60-65). The instant specification teaches that "water-in-water emulsion" is formed by mixing together cationic polymer and water soluble salts in a surfactant medium (instant specification, bottom of page 1, top of page 2). Equivalently, the '576 prior art teaches mixing a preferably cationic polymer (Col. 2, lines 15-20) (i.e. Merquat 100, example 4) and the anionic surfactant (Col 2, lines 64-end; Col.3, lines 1-5; Col. 3, lines 60-68)(sodium lauryl ether sulphate, Example 4) to obtain a complex. The examiner notes that as disclosed by Example 4, the sodium lauryl ether sulphate is present in approximately 2.5x's the amount of the Merquat. Hence, the medium is a surfactant medium. Subsequently, the water soluble salts (i.e.

sodium chloride, example) are mixed with the cationic polymer, in the surfactant medium to make the crystals dissolve/dissociate (Col. 4, lines 25-30) so that they are water enough such that they disperse in water as a single phase (i.e. don't fall out of solution)(Example 4) . Hence, a water-in-water emulsion is formed.

With regard to the composition being a cosmetic composition, the examiner notes that the composition is applied to the human body for cleansing, which beautifies the body.

Claim 2: The limitations of instant claim 1 are addressed supra. As discussed supra, the ratio of sodium chloride to Merquat 100 is 12.

Claims 3 and 4: The limitations of instant claim 1 are addressed supra. The surfactant, sodium lauryl ether sulfate is an anionic surfactant. While use of combining the anionic surfactant with an amphoteric surfactant is not immediately envisaged (since it is optional) in Example 4, the '576 prior art teaches use of the amphoteric surfactant coco-amido betaine to aid in the solubilization of perfume into the composition (Col 5, lines 20-35; Col. 6, line 25) . The '576 prior art utilizes permissive language to indicate use of perfume and amphoteric surfactants are optional. "Perfume and colouring agents *may* be also incorporated into the rinse conditioner." (Col. 5, lines 20-25). "If perfume oil is included....it may be advantageous in order to solubilize e the perfume to also incorporate a neutral surfactant... Suitable neutral surfactants are amphoteric surfactants...." (Col. 5, lines 20-35).

Claim 19: The '576 prior art explicitly teaches a method of conditioning hair (i.e. treating keratin materials) by applying the aqueous hair rinse conditioner to wet hair

and thereafter rinsing the hair with water. (Col 5, lines 45-50) Example 4 of the '576 prior art teaches that composition is a hair rinse conditioner, implying that the conditioner is applied to hair (a keratin material) and rinsing it out (Col 7, lines 55-60). With regard to the composition being applied in an effective amount, the '576 prior art teaches that wet combing value for the composition of Example 4 is 30 (Col 8, lines 1-2). A lower number indicates less combing time. Since the combing time is not in an upper range [i.e. closer to 100 (see Cols 6 and 7 for calculation of combing time)], one can conclude that composition of example 4 and the amount that was applied, was effective.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,940,576 (hereinafter the '576) by Walsh.

The limitations of instant claims 1-4 are addressed supra. The '576 prior art, Example 4, explicitly discloses use of an anionic surfactant (sodium lauryl ether sulphate) (Col. 7).

The '576 prior art also teaches use of the amphoteric surfactant, coco-amido betaine, to aid in the solubilization of perfume into the composition (Col 5, lines 20-35; Col. 6, line 25). Use of perfume and the amphoteric surfactant, coco-amido betaine, is embodied in Examples 1 and 2.).

Although the '576 prior art teaches use of the amphoteric surfactant, coco-amido betaine, use of amphoteric surfactants in Example 4 are not envisaged and therefore the instant rejection is made under obviousness.

However, it would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to look at the guidance provided by the '576 prior art incorporate amphoteric surfactants and perfume into the composition. One would have been motivated to do since the '576 prior art suggests use of perfumes and amphoteric surfactants for inclusion in the hair conditioner and it is within the skill of an artisan to utilize an expressly taught amphoteric surfactant to provide the desired effect of perfume solubilization. Therefore, if a skilled artisan wanted a good smelling hair conditioner, one would have been motivated to utilize a perfume and utilize amphoteric surfactant to solubilize the fragrance.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 940,576 (hereinafter the '576) by Walsh, as applied to instant claim 5 above, and in further view of the combined teachings of US Publication No. 2001/0051142 (hereinafter the '142) by Duden et al. and US Patent No. 6,087,403 (hereinafter '403) by Bertho *et al.*

The '576 prior art teaches inclusion of an amphoteric surfactant. Use of coco-amido betaine is embodied in Examples 1 and 2 (Cols 6-8).

However, the '576 prior art does not teach the amphoteric surfactants recited in instant claim 8.

The '403 prior art teaches that alkyl betaines are used for producing washing emulsions such as moisturizing creams, or shaving emulsions (Col. 9 lines 5-15).

The '142 prior art teaches use of alkyl betaines with lauryl betaine (a C₁₂ alkyl betaine) preferred (paragraph 88) in a non-irritating composition (abstract). The examiner notes that this conditioning composition is similar to that of the '576 prior art in that it is clear (paragraphs 160, 248, 249) and also comprises: a) cationic polymer (paragraphs 159-160; claim 1), b) anionic surfactant (claim 1, c) amphoteric surfactant (claim 1) and d) nonionic surfactant (claim 1).

Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have utilized a (C₈-C₂₀) alkylbetaine, such as lauryl betaine, in the conditioning composition taught by the '576 prior art. One would

have been motivated to do so in order to increase the "creaminess" of the conditioning composition taught by the '576 prior art while maintaining its non-irritating properties.

Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORI MATTISON/
Examiner, Art Unit 1619

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615